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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,421	01/07/2002	Dave Parsons	CV-0290	3678

7590 04/15/2003

Bristol Myers Squibb Company
100 Headquarters Park Drive
Skillman, NJ 08558

EXAMINER

PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 04/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/936,421

Applicant(s)

PARSONS et al.

Examiner

John Pak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- ### Disposition of Claims
- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5-8 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Claims 1-8 are pending in this application.

Claims 5-8 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on another multiple dependent claim. See MPEP § 608.01(n). Accordingly, claims 5-8 have not been further treated on the merits. Applicant is advised that claims 7-8 are further problematic in that they are directed to the non-statutory "use" of a substance.

Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) Claim 1 is confusing in that it is not clear whether a final iodine preparation or a two-part precursor preparation is being claimed.

(2) Claim 2 recites a broad range and a preferred range for iodine generation. This type of claim structure renders the claim indefinite because it is unclear whether the broad-narrow feature is limiting or exemplary.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Winicov et al.

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Winicov et al. (US 4,271,149) explicitly disclose a composition that contains iodine, 0.05-0.5% iodide ion from any source, 0.05-0.1% iodate from any source, detergent or solvent, and buffering agent to maintain pH in the range of 5-7 (column 2, lines 43-54). Table III discloses Composition B, which contains 0.45% HI, 0.2% sodium iodate, citric acid + sodium hydroxide (which would generate the citric acid/citrate buffer), and final pH of 5.6. See columns 7-8.

It is noted that Winicov's disclosure does not expressly mention several of applicant's claimed features. First, there is no explicit separate keeping of the iodine source and iodate (oxidant) source. However, to the extent that the claims are readable on the final solution after mixing, Winicov et al. clearly disclose the final solution. It must be emphasized that the claims are directed to the composition per se, not to a method of using the composition.

Second, claim 2 requires that the composition is capable of generating from 5 ug of iodine per g of composition per hour to 1500ug of iodine per g of the composition per hour. This feature is not expressly disclosed by Winicov et al. However, it is noted that the claims are readable on the weight amount of Winicov's HI and sodium iodate. See the non-examined claim 5 solely for the fact that applicant considers 0.2% HI to be suitable. Since Winicov et al. disclose 0.45% HI, the iodine generation feature of claim 2 is necessarily met by Winicov et al.

Third, and similarly as in the preceding paragraph, Winicov et al. do not expressly disclose generating said amounts of iodine over a period of three days. But again, applicant's claim 6 is evidence that Winicov's composition would have been so capable.

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Therefore, all of the claim features in claims 1-4 are either explicitly or necessarily disclosed by Winicov et al. and the claims must be rejected.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Pak whose telephone number is (703) 308-4538. The Examiner can normally be reached on Monday through Friday from 7:30 AM to 4 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.



JOHN PAK
PRIMARY EXAMINER
GROUP 1600